

REMARKS

Expert Declaration Submitted Under 37 CFR 1.132

The Applicant has submitted an expert declaration under 37 CFR 1.132. Said declaration is by Nathan A. Thompson Ph.D., CCOA. Dr. Thompson is a vice president of Assessment Systems Corporation in St. Paul MN. His responsibilities include the design and development of computerized psychometric tests. In addition, he has a Ph.D. in Psychometrics from the University of Minnesota with a supporting area of industrial/organizational psychology. He is therefore qualified to render opinions on the subject matter of patent application "Risk Classification Methodology", US patent application serial number 10/601118 (Robertson et al.) and the cited prior art, Lajunen et al. He is also of at least ordinary skill in the art.

Rejection under 35 USC § 112 first paragraph

The Examiner has rejected claims 37 – 39 and 44 – 46 under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. The Examiner has asserted that the claims(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner has further asserted that because the survey method described in steps d. through g. of claim 37 produced four target questions in the Applicants' trial of said method, that there was insufficient evidence that, at the time the invention was made, Applicant was in possession of a method that could produce more than four questions.

The Applicants have submitted a declaration under 37 CFR 1.132 by Dr. Nathan A. Thompson (Thompson) as rebuttal evidence that they were, in fact, in full possession of said claimed method.

The Examiner is referred to the answer to question 1 of Thompson wherein he states:

There is enough information in Robertson et al. for a person qualified in the field of computer implemented psychometric test design to develop a list of more than four target questions.

Thus the Applicants have demonstrated that they were in possession of a method in which greater than four target questions could be produced. Claim 37 therefore cannot be rejected under 35 U.S.C. 112. Claims 38-39 and 44-46 depend upon claim 37 and cannot be rejected for the same reason.

Rejection under 35 USC § 101

The Examiner has rejected claims 37 – 39 and 44 – 46 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The Court of Appeals for the Federal Circuit recently held that “the applicable test to determine whether a claim is drawn to a patent–eligible process under § 101 is the machine-or-transformation test...” *In re Bilski*, 2007-1130, 2008 WL 4757110 at *15 (Fed. Cir. 2008).

Claim 37 has been amended to include the limitation that step g. is performed on a computer modified to calculate multiple correlations and levels of statistical confidence. Thus claim 37 is tied to a particular machine and cannot be rejected under 35 U.S.C. 101. Claims 38-39 and 44-46 depend upon claim 37 and cannot be rejected for the same reason.

Rejection under 35 USC § 103

The Examiner has rejected claims 37 – 39 and 44 – 46 under 35 U.S.C. 103(a) as being unpatentable over Haner (Charles F. Haner, *A prediction of Automobile Claims by Psychological Methods*, The Journal of Risk and Insurance, vol. 35, no. 1 (Mar. 1968), pp. 49 – 59) in view of Lajunen et al. (Timo Lajunen & Heikki Summala, *Driving Experience, Personality, and Skill and Safety-Motive Dimensions in Drivers' Self-Assessments*, Person. Individ. Diff. Vol. 19, No. 3 (1995), pp. 307 – 318) and DeTore et al. (US patent 4,975,840).

Regarding Claim 37, Step a

The Examiner has asserted that Lajunen et al. provided a set of four or more target questions to a population, said target questions having been devised by a survey method.

The Applicant respectfully disagrees. As indicated in Thompson's answer to question 2:

Lajunen selected the target questions for their survey from a set of candidate questions found in a number of known personality tests based on theoretical considerations, not empirical results.

Nor is there any motivation for a person of ordinary skill in the art to modify Lajunen to select questions based on a survey method. As Thompson further states in his detailed answer to question 2:

It would have required a pilot study to select items based on empirical aspects for inclusion in the final study. Selecting the best items in each of these scales, however, was not the goal of their research.

Thus claim 37 cannot be rejected under 35 U.S.C. 103 as being unpatentable over Haner in light of Lajunen and DeTore. Claims 38-39 and 44-46 depend upon claim 37 and cannot be rejected for the same reason.

Regarding Claim 37, Step d

The Examiner has asserted that Lajunen et al. provided a set of candidate questions that are indicative of personality traits that may affect accident reporting.

The Applicant respectfully disagrees. As indicated in Thompson's answer to question 3:

The most significant major personality factors related to a person's tendency to report an accident are Conscientiousness and Agreeableness. Lajunen et al. did not measure either of these traits. Their absence is noteworthy.

Nor would a person of ordinary skill in the art have a motivation for modifying Lajunen et al. to include these personality traits. As Thompson further states in his detailed answer to question 3:

The goal of Lajunen's study was correlating personality factors with perceived driving skill and safety, not accident reporting. The variables utilized reflect this; traits found in the rows of Table 4 include sensation seeking, competitiveness, and other traits that might be linked to safety. Accident reporting is a different type of dependent variable.

Thus claim 37 cannot be rejected under 35 U.S.C. 103 as being unpatentable over Haner in light of Lajunen and DeTore. Claims 38-39 and 44-46 depend upon claim 37 and cannot be rejected for the same reason.

Regarding Claim 37, Step e

The Examiner has asserted that Lajunen et al. discloses a technique of providing a survey comprising questions indicative of personality traits to a sample population of 200 or more people.

The Applicant respectfully disagrees. As indicated in Dr. Thompson's answer to question 4:

Lajunen et al. reported a study that only used 113 subjects.

Nor would a person of ordinary skill in the art have a motivation for modifying Lajunen et al. to include providing a survey to 200 or more people. As Thompson further states in his detailed answer to question 4:

The key difference is the dependent variable. Lajunen et al. utilized psychological rating scale type self-report measures as dependent variables, whereas Robertson et al. utilized actual accident and involvement dependent variables. 113 subjects was a large enough sample for Lajunen et al.'s purpose. Increasing the number to 200 or more would have significantly added to the cost of the study without necessarily increasing the validity of the results.

113 is substantially less than 200. Thus claim 37 cannot be rejected under 35 U.S.C. 103 as being unpatentable over Haner in light of Lajunen and DeTore. Claims 38-39 and 44-46 depend upon claim 37 and cannot be rejected for the same reason.

Further Regarding Claim 37, Step e

The Examiner has asserted that Spolander (1993) as referenced in Lajunen et al., page 307, paragraph 2, provides a survey comprising questions that are indicative of personality traits.

The Applicant respectfully disagrees. As indicated in Dr. Thompson's answer to question 5:

Lajunen et al. does not give any indication that Spolander's study comprised items that are indicative of personality traits that may affect accident involvement and reporting.

Nor would a person of ordinary skill in the art have a motivation for modifying Spolander's survey to include items that are indicative of personality traits. As Dr. Thompson further states in his detailed answer to question 5:

Given Lajunen's description, it appears that the primary purpose of Spolander's research was to explore the gap between actual and perceived driving skill, with no mention of personality traits.

Thus claim 37 cannot be rejected under 35 U.S.C. 103 as being unpatentable over Haner in light of Lajunen and DeTore. Claims 38-39 and 44-46 depend upon claim 37 and cannot be rejected for the same reason.

Regarding Claim 37, Step f, sub step iii, and Step g

The Examiner has asserted that Lajunen performed a statistical analysis wherein he controlled for the age of the subjects.

The Applicant respectfully disagrees. As indicated by Thompson's answer to question 6:

Lajunen et al. sampled a population of university students that were all about the same age. It is not possible to meaningfully control for age if all of the sample population has about the same age.

Nor would a person of ordinary skill in the art have a motivation for modifying Lajunen et al. to control for the age of the subjects. As Dr. Thompson further states in his detailed answer to question 6:

This further speaks to the limited scope and purpose of the Lajunen study; they were primarily interested in the psychological factors that would be common across ages...

Thus claim 37 cannot be rejected under 35 U.S.C. 103 as being unpatentable over Haner in light of Lajunen and DeTore. Claims 38-39 and 44-46 depend upon claim 37 and cannot be rejected for the same reason.

Further Regarding Claim 37, Step g

The Examiner has asserted that Lajunen et al. performed a statistical analysis of the results of their survey to select a set of four or more target questions.

The Applicant respectfully disagrees. As indicated by Thompson's answer to question 7:

Lajunen et al. made no attempt to reduce the number of items to a critical few correlated with accident involvement. Nor would it have been possible based on their method of data analysis.

Nor would a person of ordinary skill in the art have a motivation for modifying Lajunen et al. to analyze the results of their survey to select a set of four or more target questions. As Dr. Thompson further states in his detailed answer to question 7:

Table 4 examines only full scales and subscales, not individual items, as Lajunen was interested in which psychological scales/subscales would correlate with the self-report factors.

Thus claim 37 cannot be rejected under 35 U.S.C. 103 as being unpatentable over Haner in light of Lajunen and DeTore. Claims 38-39 and 44-46 depend upon claim 37 and cannot be rejected for the same reason.

As per claim 38:

The Examiner has rejected claim 38 under 35 U.S.C. 103 as being unpatentable over Haner in light of Lajunen and DeTore. The Examiner asserts that Lajunen discloses a method wherein said set of four or more target questions selected by a survey method comprises not more than ten questions.

The Applicant respectfully disagrees. As indicated by Thompson's answer to question 7:

Lajunen et al. made no attempt to reduce the number of items to a critical few correlated with accident involvement. Nor would it have been possible based on their method of data analysis.

Nor would a person of ordinary skill in the art have a motivation for modifying Lajunen et al. to reduce the number of target questions. As Thompson further states in his detailed answer to question 7:

Table 4 examines correlations between personality scales and the self-report driver skill inventory factors. This table, however, did not provide any evidence that Lajunen et al.'s survey could be shortened and still obtain meaningful results.

Thus claim 38 cannot be rejected under 35 U.S.C. 103 as being unpatentable over Haner in light of Lajunen and DeTore.

As per claim 39:

The Examiner has rejected claim 39 under 35 U.S.C. 103 as being unpatentable over Haner in light of Lajunen and DeTore. The Examiner asserts that Lajunen discloses a method wherein a set of four or more questions comprises not more than four questions.

The Applicant reiterates the arguments presented with respect to claim 38.

Claim 39 therefore cannot be rejected under 35 U. S. C. 103 as being unpatentable over Haner in light of Lajunen and DeTore.

As per claim 44:

The Examiner has rejected claim 44 under 35 U.S.C. 103 as being unpatentable over Haner in light of Lajunen and DeTore.

The Examiner asserts that the “personal history form” of Haner corresponds to the “second set of questions” of claim 44. The Examiner then further asserts that Haner classifies said prospective insureds into a risk class based at least in part on said personal history form.

The Applicant disagrees.

Haner states:

...the personal history form is not used for rating purposes....

(Haner page 51 paragraph 3).

Claim 39 therefore cannot be rejected under 35 U. S. C. 103 as being unpatentable over Haner in light of Lajunen and DeTore.

As per claim 45:

The Examiner has rejected claim 45 under 35 U.S.C. 103 as being unpatentable over Haner in light of Lajunen and DeTore.

The Examiner has asserted that the specific content of the questions is a matter of mere user choice / design choice.

The Applicant respectfully disagrees. As indicated in Thompson’s answer to question 3:

The most significant major personality factors related to a person’s tendency to report an accident are Conscientiousness and Agreeableness. Lajunen et al. did not measure either of these traits. Their absence is noteworthy.

Nor would a person of ordinary skill in the art have a motivation for modifying Lajunen et al. to include these personality traits. As Thompson further states in his detailed answer to question 3:

The goal of Lajunen's study was correlating personality factors with perceived driving skill and safety, not accident reporting. The variables utilized reflect this; traits found in the rows of Table 4 include sensation seeking, competitiveness, and other traits that might be linked to safety. Accident reporting is a different type of dependent variable.

Thus claim 45 cannot be rejected under 35 U.S.C. 103 as being unpatentable over Haner in light of Lajunen and DeTore. Claims 38-39 and 44-46 depend upon claim 37 and cannot be rejected for the same reason.

Response to Examiner's Notes

The self-reported accidents of Lajunen et al. are not the functional equivalents of the auto insurance claims of Robertson et al.

The Examiner has asserted that the self-reported accidents of Lajunen are functional equivalents to the accident claims of the Applicant.

The Applicant respectfully disputes this assertion and requests that the Examiner provide evidence to support it if the Examiner wishes to continue to assert it in future correspondence. As indicated by Thompson's detailed answer to question 4:

The key difference is the dependent variable. Lajunen et al. utilized psychological rating scale type self-report measures as dependent variables, whereas Robertson et al. utilized actual accident involvement dependent variables....

Lajunen et al. were interested in correlating personality variables with psychological variables, and Robertson et al. correlated personality variables with actuarial variables. Specifically, the actuarial variable, "accident involvement and

reporting” as described in Robertson et al. is not found in Table 1 of Lajunen et al. Lajunen’s Table 1 presents the dependent primary variables of the study, which were underlying factors of self-reported driving characteristics, derived by a factor analysis.

The number of target questions in Robertson et al. was not a mere design choice.

The Examiner has asserted that the number of target questions in the Applicant’s invention is a mere design choice.

The Applicant respectfully disputes this assertion and requests that the Examiner provide evidence to support it if the Examiner wishes to continue to assert it in future correspondence. As indicated by Dr. Thompson’s detailed answer to question 8:

The number of target items was determined by the actual results Robertson et al. got in their study. It was not a mere design choice.

The four target questions do not constitute a known personality measure.

The Examiner has asserted that the collective responses to the set of four or more target questions claimed by the Applicant constitute a known personality measure.

The Applicant respectfully disputes this assertion and requests that the Examiner provide evidence to support it if the Examiner wishes to continue to assert it in future correspondence. As indicated in Thompson’s answer to question 9:

The four questions identified by Robertson et al. do not cover any recognized single personality trait.

Moot Rejections

In this response, the Applicant makes no admission concerning any now moot rejections or objection, and affirmatively denies any position, statement, or averment of the Examiner that was not specifically addressed herein.

CONCLUSION

Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Mark Nowotarski, Applicants' Agent at 203 975 7678 so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

A handwritten signature in cursive script that reads "Mark Nowotarski".

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